

### REMARKS

Applicants would like to thank Examiner Yan for the courtesies extended to Applicants' representative during their telephone conferences on December 12, 2008, and December 15, 2008. During the interviews, the Office Action rejections were discussed with respect to the claims. The Office Action dated September 30, 2008, has been reviewed and the Examiner's comments carefully considered.

Claims 1-21 are pending in the application. Claims 1, 2, 8, 9, 12, 15, and 16 are presently amended. No new matter has been added. Support for these amendments can be found in the specification and drawings as originally filed. Specifically, support for these amendments can be found in the specification at page 3, paragraph [0051], lines 8-13 of the published application. Accordingly, claims 1-21 are currently pending in this application and claims 1, 12, and 15 are in independent form.

#### 35 U.S.C. §102 Rejections

Claims 1, 2, 6, 9-12, 15, and 16 stand rejected under 35 U.S.C. §102(b) for anticipation by U.S. Patent No. 5,167,739 to Hutchinson et al. (hereinafter "the Hutchinson patent"). In view of the above amendments and the following remarks, the Applicants respectfully request reconsideration of these rejections.

The Hutchinson patent is directed to a method of forming a multi page mailer type business from three different sheets, a top sheet (10), a middle sheet (12), and a bottom sheet (13). The top and bottom sheets (10, 13) are manufactured simultaneously with perforations inside of perimeter areas of three of the edges. The sheets (10, 12, 13) are provided in a vertical stack into a laser printer (67), first printing the top sheet (10), the middle sheet (12), and then the bottom sheet (13). The printer (67) prints machine readable identification information, in the form of a bar code (69) on each of the sheets (10, 12, 13) that are to be provided in a final mailer (78). As the Examiner has stated in the Office Action, the bar code identifiers (69) are common to the envelope and insert sheets (10, 12, 13) that are to be assembled into a final multi page mailer (78).

As defined by independent claim 1, as amended, the present invention is directed to a method of forming a document set from rectangular sheets of the same size and includes an envelope sheet and at least one insert sheet. The envelope sheet is printed with envelope information, including a unique code identifier to identify the envelope sheet. Each insert sheet is

printed with a further unique code identifier to identify each of the insert sheets separately. In addition, the single envelope sheets are collated to each insert sheet by reading the unique code identifier of the envelope sheets and the further unique code identifiers of each insert sheet in order to form a document set.

The present invention uses unique code identifiers for each of the envelopes and each sheet comprising the insert sheets to be collated by the envelope. In contrast, the Hutchinson patent does not disclose or suggest the use of unique code identifiers that uniquely identify each of the envelope and sheets of the document set. As previously stated, the Hutchinson patent has common identification codes applied to all sheets, including the envelope, comprising a document set. Therefore, the Applicants believe that the subject matter of amended independent claim 1 is not anticipated by or rendered obvious over the Hutchinson patent. Reconsideration of the rejection of claim 1 is therefore respectfully requested. Claims 2, 6, and 9-11 depend from and add further limitations to independent claim 1 and are believed to be patentable for the reasons discussed hereinabove in connection with claim 1.

Independent claim 12 has been amended to recite a method of performing a document set having an envelope sheet printed with a unique code identifier to identify the envelope sheet and at least one insert sheet printed with a further unique code identifier to identify each of the insert sheets. Further, a single envelope sheet is collated with the insert sheets by reading the unique code identifier of the envelope and the further unique code identifiers of the insert sheets to form a document set. It is believed that independent claim 12 is in condition for allowance for the reasons stated hereinabove with regard to claim 1.

Amended independent claim 15 is directed toward an apparatus for forming a document set, the document set including a single envelope sheet having a unique code identifier and insert sheets having further unique code identifiers unique from the unique code identifier of the envelope. A scanner is provided for scanning the unique code identifier and the further unique code identifier of the single envelope and insert sheets. The envelope sheet is collated to the insert sheets by scanning the envelope unique code identifier and the further unique code identifier of the sheets to form a document set. It is believed that independent claim 15 is in condition for allowance for the same reasons stated hereinabove with regard to claim 1. Claim 16 depends from and adds further limitations to independent claim 15 and is believed to be allowable for the same reasons discussed hereinabove in connection with claim 15.

**35 U.S.C. §103 Rejections**

Claims 3-5, 7, 8, 13, 14, and 17-21 stand rejected under 35 U.S.C. §103(a) for obviousness over the Hutchinson patent in view of Fig. 1 and Applicants' admitted prior art (AAPA). In view of the above amendments and the following remarks, the Applicants respectfully request reconsideration of these rejections.

The AAPA is directed to closed faced envelopes using highly specialized equipment for insertion without auditing and checking of the insertion sheets. The AAPA fails to describe the use of unique code identifiers for each element of the document set, including both the envelope sheet and the insert sheet. The AAPA also fails to teach an integrity check with regard to a document set as a whole, including all of the insert sheets and the envelope. Still further, the AAPA does not teach a self referencing integrity check but instead teaches a comparison between identifier information on an insert sheet and a processed data file.

As set forth in MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be considered in judging patentability of a claim against the prior art. Where claimed limitations are simply not present in the prior art, a *prima facie* rejection is not supported unless clear articulation is given as to why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. The outstanding Office Action gives no reasoning as to the differences between the prior art and the present invention. Thus, both the Hutchinson patent and the AAPA fail to teach or suggest a method of forming a document set formed from rectangular sheets of the same size and including a single envelope sheet and at least one insert sheet, including printing the single envelope sheet with envelope information including a unique code identifier to identify the single envelope sheet, and printing insert sheets with insert information, the insert information including a further unique code identifier to identify each of the insert sheets, and the unique code identifier of the envelope sheet is unique from the further unique code identifier of each present insert sheets. In addition, both references fail to teach collating a single envelope sheet with at least one insert sheet by reading a unique code identifier of the single envelope sheet and the further unique code identifier of the at least one insert sheet to form a document set. Accordingly, in light of the absence in the cited prior art of several important features of the present invention,

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Applicants submit that a *prima facie* case of obviousness is not established. The pending Claims 3-5, 7, 8, 13, 14, and 17-21, which depend from independent claims 1, 12, and 15 are believed to be allowable for at least these reasons as well as for the reasons discussed hereinabove with regard to claims 1, 12, and 15.

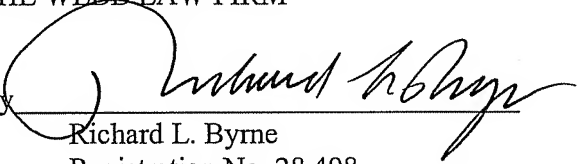
**CONCLUSION**

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-21 are respectfully requested.

Respectfully submitted,

THE WEBB LAW FIRM

By



Richard L. Byrne  
Registration No. 28,498  
Attorney for Applicants  
436 Seventh Avenue  
700 Koppers Building  
Pittsburgh, PA 15219  
Telephone: (412) 471-8815  
Facsimile: (412) 471-4094  
E-mail: webblaw@webblaw.com